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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,710	02/20/2004	Koji Sakuta	TAKIT-144-D2	4197

23599 7590 03/26/2007  
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
2200 CLARENDON BLVD.  
SUITE 1400  
ARLINGTON, VA 22201

EXAMINER
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ROBERTS, LEZAH

ART UNIT	PAPER NUMBER
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1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/781,710	<b>Applicant(s)</b> SAKUTA, KOJI	
	<b>Examiner</b> Lezah W. Roberts	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 8-58 is/are pending in the application.
- 4a) Of the above claim(s) 51 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-50 and 52-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

This Office action is in response to the Amendment filed April 24, 2006. All previous rejections have been withdrawn unless stated below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election by Original Presentation***

Newly submitted claims 51 and 58 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims recite a method whereas the previously presented claims recite a composition. Had the claims been originally presented the claims would have been restricted accordingly.

- I. Claims 8-50 and 52-57, drawn to a dermatic cosmetic material, classified in class 424, subclass 401.
- II. Claims 51 and 58, drawn to a method of using a dermatic cosmetic material, classified in class 514, subclass 63.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of

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using that product. See MPEP § 806.05(h). In the instant case invention I may be used in cosmetics such as makeup.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 51 and 58 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Specification***

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f). See page 11 where the Japanese patent application 11-177904 is incorporated by reference into the specification.

## ***Claims***

### **Claim Rejections - 35 USC § 112 – Indefiniteness (New Rejection)**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 32 recites the limitation "claim 32" in the first line of the claims. There is insufficient antecedent basis for this limitation in the claim because it is dependent on itself.

### **Claim Rejections - 35 USC § 102 – Anticipation (New Rejection)**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8-47, 50 and 52-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Brieva et al. (US 6,103,250).

Brieva et al. disclose anhydrous cosmetic compositions containing emulsifying siloxane elastomers. The cosmetics include antiperspirants and deodorants. The

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siloxanes include organohydrogenpolysiloxane. The organohydrogenpolysiloxane have a formula of  $R_a^1 R_b^2 H_c SiO(4-a-b-c)/2$  (col. 3, lines 28-60). Although the formula of the reference and the formula of the instant disclosure are slightly different, the definition of the values represented by the letters overlap one another. Particulate fillers may be surface treated with silicone oil (col. 5, lines 32-35). The silicone oils include dimethicone, amodimethicone, hexadecyl methicone, methicone, phenyl trimethicone, simethicone, dimethylhydrogensiloxane, vinyl dimethicone, and mixtures thereof. Volatile silicones include octamethylcyclotetrasiloxane, decamethylcyclopentasiloxane, hexamethyldisiloxane, and mixtures thereof and have a viscosity ranging from 0.5 to 10 centipoise at 25°C (0.22 to 4.4 mm<sup>2</sup>/s). The silicone oils used are non-volatile oils with a viscosity ranging from 10 to 100,000 centipoise at 25°C (0.44 to 44000 mm<sup>2</sup>/s). This range encompasses the instant claims because 1 centipoise is 0.44 mm<sup>2</sup>/s (col. 8, lines 1-15). Antiperspirant salts include aluminum zirconium trichlorohydrate and aluminum chlorohydrate (col. 5, line 46 to col. 6, line 13). In regards to the amounts by parts, it is not clear because there is no final volume, weight or parts. Because the compositions read on 1:1 values, the reference encompasses the instant claims. For instance, in example 3, the silicone elastomer makes up 15%; the dimethicone and stearyl dimethicone combined make up 15%. When adding all the silicone oils, they total 22%, which may translate 22:15 silicone oil to silicone elastomer falling within the recited parts. In the antiperspirant compositions, aluminum comprises 25% of the compositions. Relative to the silicone oil and silicone elastomer, this falls into the range of the instant claims. Alcohols are used in the compositions and include glycerine. It is disclosed

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anhydrous polar ingredients, for example, mono- and difunctional alcohols like glycerin, propylene glycol, and the like, are known for their ability to improve formula aesthetics and are often used as carriers for skin treatment actives. Also used is ascorbic acid (vitamin C) and makes up 48% of the compositions (see Examples). The antiperspirant compositions include stearyl alcohol and hydrogenated castor oil encompassing claim 23. The reference anticipates the claims insofar as it discloses a non-aqueous dermatic cosmetic material comprising a silicone paste and an aluminum compound.

**Claim Rejections - 35 USC § 103 – Obviousness (New Rejections)**

1) Claims 8-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakuta (EP 0 501 791) in view of Shin (US 4,937,069).

Sakuta discloses silicone polymers obtained by the addition of at least one organohydrogenpolysiloxane and a polyoxyalkylene and/or organopolysiloxane. The polymer is capable of being swollen with silicone oil to give a uniform, pasty composition without use of any surface active agent and may be used in cosmetics and medicines (see Abstract). The silicone oils include dimethylpolysiloxane and decamethylcyclopentasiloxane, encompassing claim 13. The viscosity of the oil is no higher than 100 centistokes at 25°C, encompassing claims 19-20 (page 5, lines 10-12). The disclosed compositions include polyhydric alcohols such as 1,3 butyl glycol (see Examples). In regards to the non-aqueous limitation, the claims recite a cosmetic material. They do not stipulate the compositions cannot be incorporated into an aqueous composition. The reference does not specifically disclose that the disclosed

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compositions are used only in compositions comprising water, therefore it may be used in non aqueous compositions. In regards to the amounts by parts, it is not clear because there is no final volume, weight or parts. The reference differs from the instant claims insofar as it does not disclose an aluminum compound in combination with the silicone composition paste.

Shin et al. discloses anhydrous compositions comprising silicon oils. Disclosed are problems associated with hydrous compositions. The problem with hydrous compositions is the problem of syneresis or bleeding from the thixotropic gel system in which the liquid contained in the semi-solid stick separates out resulting in an unappealing product and fabric staining. Other problems encountered with semi-solid sticks are that they are sometimes too hard, this interferes with the ability to dispense these products from a roll-on or extruding package, and undesirable wet, cold and sticky sensations experienced when aqueous based products are applied to the skin (col. 1, lines 21-38). Silicone oils include dimethyl polysiloxane and cyclomethicone. The disclosed compositions comprise antiperspirant actives such as aluminum compounds including aluminum zirconium tetrachlorohydrate ( $\text{Al}_4\text{Zr}(\text{OH})_{12}\text{Cl}_4$ ); aluminum zirconium trichlorohydrate and aluminum chlorohydroxide (col. 2, line 53 to col. 3). The compositions may also comprise stearyl alcohol or Alcohol SD-40, encompassing claims 16-18 and 23 (Example 4). The reference differs from the instant claims insofar as it does not disclose using organohydrogenpolysiloxane in the antiperspirant compositions.



It is *prima facie* obviousness to select a known material based on its suitability for its intended use. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Also, established precedent holds that it is generally obvious to add known ingredients to known compositions with the expectation of obtaining their known function. See, e.g., *In re Linder*, 457 F.2d 506, 507 (CCPA 1972); see also *In re Dial*, 326 F.2d 430, 432 (CCPA 1964). It would have been obvious to one of ordinary skill in the art to have used the aluminum compounds in conjunction with the compositions of the primary reference motivated by the desire to use an antiperspirant active for its known function when using the organohydrogenpolysiloxane in an antiperspirant cosmetic composition. Alternatively, it would have been obvious to one of ordinary skill in the art to have used the organohydrogenpolysiloxane in the compositions of the secondary reference motivated by the desire to eliminate the problems of stability associated with the oils used separating out of the compositions by using a component that absorbs oils such as silicone oils that are used in the deodorant compositions as supported by the primary reference.

2) Claims 24-47, 50 and 52-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakuta (EP 0 501 791) in view of Powell et al. (US 6,060,546).

The primary reference is discussed above. The reference discloses organohydrogenpolysiloxane materials for cosmetic compositions. The examples describe a procedure wherein when the cosmetics are made using these materials, water is added last. Therefore before the water is added the compositions are

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anhydrous materials. The reference differs from the instant claims insofar as it does not disclose using vitamin C in the cosmetic compositions.

Powell et al. disclose non-aqueous silicone emulsions. The reference is used primarily as a resource to disclose components used in different non-aqueous cosmetic compositions depending on the cosmetic compositions desired. These cosmetics include antiperspirants and deodorants (col. 16, line 47). The compositions comprise a silicone phase, comprising a silicone elastomer, a low molecular weight silicone compound and an organic phase, comprising an organic liquid. The compositions included mixtures of decamethylcyclopentasiloxane and isopropanol (see Examples). The organic liquids include ethanol, propylene glycol, dipropylene glycol tripropylene glycol and glycerin. The personal care products may comprise ascorbic acid or an enzyme. Antiperspirant compositions comprise actives such as aluminum hydroxyhalides, aluminum chlorohydrate, and complexes or mixtures thereof with zirconyl oxyhalides and zirconyl hydroxyhalides, such as aluminum-zirconium chlorohydrate (col. 17, lines 9-16). The compositions may also comprise vitamins. The reference differs from the instant claims insofar as it does not disclose using organohydrogenpolysiloxane in the compositions.

It would have been obvious to one of ordinary skill in the art to have used the aluminum compounds and the ascorbic acid in conjunction with the compositions of the primary reference motivated by the desire to use personal care actives for their known function, as supported by cited precedent. See *Sinclair & Carroll Co. v. Interchemical*

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*Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See, e.g., *In re Linder*, 457 F.2d 506, 507 (CCPA 1972); see also *In re Dial*, 326 F.2d 430, 432 (CCPA 1964) as stated *supra*.

3) Claims 8-50 and 52-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakuta (EP 0 501 791) in view of Kilgour et al. (US 6,262,170).

The primary reference is discussed above. The reference discloses organohydrogenpolysiloxane materials for cosmetic compositions. The examples describe a procedure wherein when the cosmetics are made using these materials, water is added last. Therefore before the water is added the compositions are anhydrous materials. The reference differs from the instant claims insofar as it does not disclose using vitamin C or E in the cosmetic compositions.

Kilgour et al. discloses personal care compositions comprising silicone elastomers. The reference is used primarily as a resource to disclose components used in different cosmetic compositions depending on the cosmetic compositions desired. The compositions include antiperspirants (col. 8, line 1). An antiperspirant composition comprises one or more active agents, such as, aluminum halides, aluminum hydroxyhalides, for example, aluminum chlorohydrate, and complexes or mixtures thereof with zirconyl oxyhalides and zirconyl hydroxyhalides, such as for example, aluminum-zirconium chlorohydrate, and the silicone elastomer of the present invention. The skin care actives may include vitamins, such as, for example, vitamin C and vitamin E (col. 8, lines 19-38). The silicone fluid used in the compositions includes decamethylcyclopentasiloxane (col. 6, lines 53-67). Organic liquids included in the

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compositions include stearyl alcohol, ethanol, propyl alcohol, isopropyl alcohol, ethylene glycol, propylene glycol, dipropylene glycol, tripropylene glycol, butylene glycol, isobutylene glycol and glycerin (column 7). The reference differs from the instant claims insofar as it does not disclose using organohydrogenpolysiloxane in the compositions.

It would have been obvious to one of ordinary skill in the art to have used the aluminum compounds and vitamins C and E in conjunction with the compositions of the primary reference motivated by the desire to use personal care actives for their known function, as supported by cited precedent. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See, e.g., *In re Linder*, 457 F.2d 506, 507 (CCPA 1972); see also *In re Dial*, 326 F.2d 430, 432 (CCPA 1964) as state *supra*.

Claims 8-50 and 52-57 are rejected.

Claims 51 and 58 are withdrawn.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Lezah Roberts  
Patent Examiner  
Art Unit 1614

A handwritten signature in black ink, appearing to read 'Lezah Roberts', with a long horizontal flourish extending to the right.

Frederick Krass  
Primary Examiner  
Art Unit 1614

A handwritten signature in black ink, appearing to read 'Frederick Krass', with a long horizontal flourish extending to the right.